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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/350,251	07/08/1999	ARYE MALEK	6139.059US1	7789

7590

08/25/2006

Lemaire Patent Law Firm, P.L.L.C.  
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EXAMINER
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NGUYEN, JOHN QUOC

ART UNIT	PAPER NUMBER
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3654

DATE MAILED: 08/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/350,251

Applicant(s)

MALEK ET AL.

Examiner

John Q. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 27 June 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 3-10, 12-25 and 27-48 is/are pending in the application.
- 4a) Of the above claim(s) 22-25, 31-36, 41, 44 and 47 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 3-10, 12-21, 27-30, 37-40, 42, 43, 45, 46, 48 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

In view of the Appeal Brief of 6/27/06, prosecution has been reopened and the following rejection is applied.

Applicant's election of the species of figs. 19A and 19B, claims 3-10, 12-21, 27-30, 37-40, and 42 in Papers No. 27 and 29 has been acknowledged. Claims 22-25, 31-36, 41, 44, and 47 stand withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in Papers No. 27 and 29.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 12, 20, 21, 40 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is not clear how moving the tray in the claimed perpendicular direction reduces the travel distance as claimed (claims 12, 20, 21, 40). It is suggested that "to reduce a distance of travel..." be deleted since this phrase causes this rejection. Furthermore, "perpendicular to the long-dimension side" is not necessarily the same as "in the short-dimension direction" since the tray may not be rectangular; the tray may be square or may have more than four sides where the short-dimension side is not necessarily perpendicular to the long-dimension side. For example, in a seven-sided tray with each

side having a different length, it is unlikely that the “perpendicular to the long-dimension side” is “the short-dimension direction”.

All claims should be revised carefully to correct all other deficiencies similar to the ones noted above. The non-elected claims should also be similarly corrected at the same time so that the application can be allowed without delay should the generic claims become allowable.

Claims 3-9, 12-21, 27-30, 40, 42, 43, 45, 46, and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over applicant's admitted prior art in view of Jackson et al (US 6139243), Kawasaki (US-4468165), and Hinchcliffe et al (US-4303366).

The admitted prior art discussed on pages 2-5 of the specification discloses substantially all the claimed features including vision inspection systems, trays of devices to be inspected, flipping the trays to inspect both sides of the devices, mechanical translation devices. What is not disclosed is a motor-operated flipping/inverting mechanism. Jackson et al discloses another similar apparatus in which the claimed inverting means is disclosed including translation devices/conveyors 56 and flipping/inverting devices 20 (or 70) with jaws such as 50 and 107, which invert the devices in the trays<sup>12</sup> between first and second processing stations 22 and 26. Means for limiting the motion of the rotator are deemed inherent since the rotators only rotate a predetermined amount. It would have been obvious to a person having ordinary skill in the art to provide the admitted prior art apparatus with an inverting mechanism as taught by Jackson et al to automatically and reliably invert the devices in the trays. It is deemed inherent that the admitted prior art has the inverting

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done in between two inspection stations so that both sides are inspected or it would have been obvious to a person having ordinary skill in the art to provide the inverting device in between two inspection/processing stations as taught by Jackson et al. The admitted prior art also does not show the orientation of the trays while moving.

However, moving the trays along a direction perpendicular to the long side such as to fit more trays on the conveying means is old and well known in the art as evidenced by Kawasaki (note at least trays 22) and Hinchcliffe et al (note at least trays 14); therefore, It would have been obvious to a person having ordinary skill in the art to move the trays of the admitted prior art modified as above along a direction as taught by Kawasaki or Hinchcliffe et al to fit more trays on the conveying means. It is deemed inherent that the second inspection station is movable with respect to the inverting mechanism and the means for moving includes structures such as releasable screws and fastening devices or alternatively to provide the second inspection station with such means for moving would have been obvious to a person having ordinary skill in the art to adjust the position of the second inspection station to suit the particular configuration of the trays or devices to be inspected.

Claims 10 and 37-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over applicant's admitted prior art in view of Jackson et al, Kawasaki, and Hinchcliffe et al as applied to claims 3-9, 12-21, 27-30, 40, 42, 43, 45, 46, 48 above, and further in view of Bilodeau et al (US 5691810).

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Bilodeau et al discloses another similar apparatus in which a pick and place mechanism 42 removes rejected devices and replaces them with good devices. It would have been obvious to a person having ordinary skill in the art to provide the admitted prior art modified as above with a pick and place mechanism as taught by Bilodeau et al to remove rejected devices and replace them with good devices to obtain a all-good tray and reducing manual labor and manufacturing time and costs. Relative to claim 39, the number of inspection stations is deemed inherent in the admitted prior art or, alternatively, would have been an obvious matter of design choice to a person having ordinary skill in the art based on factors such as the number of features to be inspected.

Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

As noted above, it is not clear how moving the tray in the claimed perpendicular direction reduces the travel distance as claimed. The distance between the two inspection stations cannot be shorter simply because the tray is shorter. If this were true, a person can therefore reduce the distance of travel between two cities by traveling in a shorter car. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "allows the stations to be placed closer together") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification,

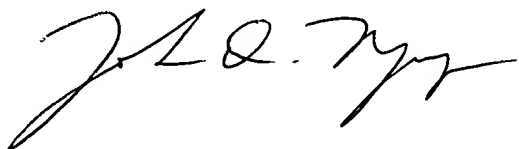
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limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Q. Nguyen whose telephone number is (571) 272-6952. The examiner can normally be reached on Monday-Friday, from 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Katherine Matecki, can be reached on (571) 272-6951. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'J. Q. Nguyen', with a stylized flourish at the end.

John Q. Nguyen  
Primary Examiner  
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